

SEP 23 2005

Our Reference: SEA-147-D

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thomas R. Tudor and William C. Paetow II  
Serial Number: 10/023,333  
Filing Date: December 12, 2001  
Examiner/Art Group Unit: Fetsuga, Robert M./3751  
Title: VISCOUS MATERIAL DISPENSE SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

If any charges or fees must be paid in connection with the following communication, they may be paid out of our Deposit Account No. 25-0115.

It is submitted that the last Office Action should not have been a Final Office Action, since the Examiner changed the grounds of rejection without permitting the Applicant an opportunity to respond to the new ground of rejection in a non-final office action. Reconsideration and withdrawal of the Finality of the last Office Action is requested.

If the Finality of the last Office Action was improper, the amendments to claims 1, 2, 4, 9, and 14 including the substitution of the term "single piece" for the term "monolithic" should have been entered as requested. Applicant requests entry of these amendments to claims 1, 2, 4, 9, and 14 in the event that the Examiner withdraws the Finality of the last Office Action. Furthermore, the Examiner treated the terms "monolithic" and "single piece" as synonymous terms in the Final Office Action, and therefore entry of the term "single piece" in place of the term "monolithic" would not require further search and/or consideration by the Examiner (see paragraphs 7 and 8 of the Office Action dated May 23, 2005).

Claims 1, 4, 9, and 14 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification

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in such a way as to reasonably convey to one skilled in the art that the inventors, at the time that the application was filed, had possession of the claimed invention. In particular, the Examiner objects to the term "monolithic" with respect to the tube member 24 and the term "monolithic" with respect to the insert 16. It is submitted that claims 1, 4, 9, and 14 have been amended to remove the term "monolithic". The configuration of the tube member 24 as a single piece can best be seen in Figure 9, while the configuration of the insert 16 as a single piece can best be seen in Figure 8. Since the configuration of the tube member 24 as a single piece and the configuration of the insert 16 as a single piece were shown in the original drawings as filed with the application, and since paragraphs [0026] and [0027] (as previously amended) incorporate this terminology (without objection by the Examiner) into the specification, it is submitted that this Amendment does not introduce any new subject matter into the application. Reversal of the Examiner's final rejection under 35 U.S.C. §112, first paragraph is requested.

Claims 4, 6, and 21 stand rejected under 35 U.S.C. §102(e) as being anticipated by Brennan et al. Brennan et al discloses a standard static mixer 16, where the static mixer shroud 20 contains mix elements 26 and a cone-shaped insert 12. (See column 2, lines 18-22) The Brennan et al reference does not anticipate, teach, or suggest a nozzle retaining annular shoulder surface adjacent one end of the tubular housing, or a nozzle insert engagable with the nozzle-retaining annular shoulder surface within the tubular housing. The Examiner refers to the nozzle-retaining annular shoulder surface (as receiving insert 12); however this is a conical surface (not an annular shoulder surface) formed at one end of the static mixer tube housing 16. See column 2, line 3 of Brennan et al. The cone-shaped insert 12 slides through the standard mixer tube 16 and rests against the conical surface formed adjacent the discharge end 18 of the tube 16. The static mixer tube 16 of Brennan et al does not have a nozzle-retaining annular shoulder for receiving an annular flange of a nozzle insert as recited in the claims of the present application. In fact, Brennan et al illustrates that the internal mixer element is received against the annular shoulder of Brennan et al, not the insert itself. This teaches away from the

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configuration as claimed in the present application. Claim 6 of the present invention recites the static mixer 14 is operably insertable within the hollow tubular housing 24 for trapping the annular flange 16b of the nozzle insert 16 against the nozzle-retaining annular shoulder surface 24d of the tubular housing 24. Brennan et al does not anticipate, teach, or suggest trapping the flange of the insert between the mixer element and the nozzle-retaining annular shoulder of the tubular housing as recited in claim 6. Brennan et al does not anticipate, teach, or suggest the nozzle insert being an interchangeable insert positionable within the second end of the tubular member against the nozzle-retaining annular shoulder surface of the static mixer tube as recited in claim 21 of the present application. Brennan et al only teaches that the cone-shaped insert 12 rests against the conical surface 18 formed in the discharge end of the static mixer tube 16. The static mixer tube 16 does not have a nozzle-retaining annular shoulder and the cone-shaped insert 12 does not have an annular flange to rest thereon. Since the cone-shaped insert 12 does not have an annular flange, the insert of Brennan et al cannot be trapped against an annular shoulder of the static mixer tube 16. In fact, Brennan et al teaches away from an annular flange on the insert 12 and teaches away from trapping the annular flange of the insert 12 between the nozzle-retaining annular shoulder surface of the tubular housing and the mixer elements as recited in claims 4, 6, and 21 of the present application. Therefore, reversal of the Examiner's final rejection of claims 4, 6, and 21 as being anticipated by Brennan et al under 35 U.S.C. §102(e) is requested.

Claims 4-5, 8-10, 12-17, and 20-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Miller. This rejection is raised for the first time in the office action dated May 23, 2005. Since this rejection is applied to claims that have not been amended in the last amendment, the Examiner is requested to withdraw the finality of this office action and to issue a new non-final office action to allow the applicant sufficient opportunity to address the new grounds of rejection raised for the first time in the last office action. Alternatively, the Examiner is requested to specifically cite the MPEP section relied on to permit withdrawal of a final rejection in order to change the ground of rejection from §102(b) to §102(e) for

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the Brennan et al reference, while also adding a new ground of rejection based on §102(b) applying the Miller reference, while issuing a final office action on claims that have not been amended. In any case, the Miller reference does not anticipate teach or suggest the invention as recited in claims 4-5, 8-10, 12-17, and 20-22, Miller states in column 4, line 44-51, that the dispensing needle assembly 40 includes a hollow cylindrical body 41 preferably formed of metal which is molded within the interior of an outer wing block connector 37 and has a hollow cylindrical dispensing tip 42 extending from the body 41, where the needle body 41 terminates in an outturned top end flange 43 which abuts against an end wall 44 of tapered male luer lock outlet nozzle 45. (Emphasis added). Claim 4 of the present application requires a tubular nozzle member and a nozzle insert engagable with a nozzle-retaining annular shoulder surface within the tubular housing, the nozzle insert having a nonlinear axially extending inner surface defining a passage therethrough with an aperture of reduced dimension adjacent the outlet. This specific structure is not anticipated, taught or suggested by the Miller reference, taken singularly or in any permissible combination. The tube 2 of Miller does not include an inwardly extending annular shoulder and/or an inner conical nozzle surface for engagement with the nozzle insert as recited in the claims. The dispensing needle assembly 40 of Miller is not a nozzle insert as required by the claims. The dispensing needle assembly 40 of Miller does not have an outwardly extending flange engagable with the inwardly extending shoulder of the tubular member as recited in the claims. The dispensing nozzle assembly 40 of Miller does not have a conical external surface extending toward a second end as recited in the claims. The Miller reference does not anticipate, teach or suggest an annular shoulder extending radially inwardly adjacent on end of the hollow tubular housing, and/or a radially outwardly extending annular flange adjacent a first end of the nozzle insert engagable with the annular shoulder. The dispensing tip 42 of the multi-part dispensing nozzle assembly 40 of Miller is not interchangeable as recited in claims 21-22. Reversal of the Examiner's final rejection of claims 4-5, 8-10, 12-17, and 20-22 as being anticipated by Miller under 35 U.S.C. §102(b) is requested.

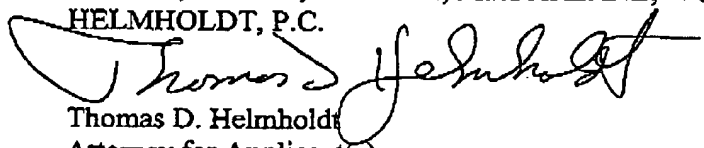
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Claims 1-6, 8-18, and 20-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brennan et al, Miller and Keller et al. The Brennan et al, Miller, and Keller et al references, taken singularly or in any permissible combination, do not anticipate, teach, or suggest the present invention as recited in claims 1-6, 8-18, and 20-22. The addition of the Keller et al reference to Brennan et al and/or Miller does not overcome the deficiencies of the Brennan et al reference previously described above in detail. In particular, the Keller et al reference teaches an externally stepped housing, but does not teach a nozzle insert with an outwardly extending flange engagable with an inwardly extending shoulder of the tubular nozzle member as recited in claims 1-6, 8-18, and 20-22. The Miller reference can not be properly combined with either the Brennan et al. reference and/or the Keller et al. reference, since to do so would destroy the teaching of the multi-part housing inherent in the Miller disclosure. (See Miller, column 4, line 44-51). In the configuration illustrated by Miller, the mixer element 48 is spaced from the top end flange 43 by end wall 44 of nozzle 45. Therefore, the Miller reference does not teach or suggest trapping the flange 43 of an insert (or an insert assembly) against the nozzle-retaining annular shoulder surface with the mixer element as recited in claims 6, 11, and 18 of the present application. Reversal of the Examiner's final rejection of claims 1-6, 8-18, and 20-22 as being obvious in view of Brennan et al, Miller and Keller et al. under 35 U.S.C. §103(a) is requested.

Respectfully submitted,

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